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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,440	04/19/2006	Daisuke Itoh	WAKAB81.003APC	9670
20995 7590 01/14/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
ZHU, WEIPING				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
01/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/595,440

Applicant(s)

ITO ET AL.

Examiner

WEIPING ZHU

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-22 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) 3-14, 16-18, 20-22, 24-28, 30-34 and 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 15, 29 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 2, 15, 29 and 35 are currently under examination, wherein the claims 1, 15 have been amended and the claims 29 and 35 have been newly added in applicant's amendment filed on November 24, 2008. The newly added claims 30-34 and 36-40 in the same amendment, which are dependent on previously withdrawn claims, have been withdrawn from consideration. The applicant has protested in the amendment filed on November 24, 2008 the restriction requirement, which was made final in the Office action dated August 22, 2008. The applicant is advised herein to file a petition directly to the Office of the TC 1700 director of the USPTO in order to revert the restriction requirement.

Status of Previous Rejections

2. The previous rejections of claims 1, 2 and 15 under 35 U.S.C. 103(a) as being unpatentable over JP 2002-334618 A as stated in the Office action dated August 22, 2008 are maintained as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 15, 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-334618 A.

Claims 1, 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-334618 A as stated in the Office action dated August 22, 2008.

With respect to the amended feature of the average particle size in the instant claims 1 and 15, JP ('618 A) discloses that the average particle size is preferred in the range of 2 to 10 nanometers (paragraph [0022], machine translation), which is within the claimed range. A prima facie case of obviousness exists. See MPEP 2144.05 I.

With respect to the claimed feature of the compounds in the instant claims 1 and 15, JP ('618 A) discloses that the compounds comprise alkylamines (paragraphs [0026]-[0028], machines translation), which read on the claimed compounds.

With respect to the claimed feature of the thickness of the covering layer in the instant claims 1 and 15, JP ('618 A) does not specify the thickness as claimed. However, it is well held that discovering an optimum value of a result-effective variable involves only routine skill in the art. In re Boesch, 617, F.2d 272, 205 USPQ 215 (CCPA 1980). In the instant case, the thickness is a result effective variable, because it would directly affect the final properties of the particles as disclosed by JP ('618 A) (paragraph [0023]). Therefore it would have been obvious to one skilled in the art to have optimized the thickness of the covering layer on the particles of JP ('618 A) in order to achieve the desired properties of the particles. See MPEP 2144.05 II.

With respect to claim 29, JP ('618 A) discloses that the compounds comprise alkylamines (paragraphs [0026]-[0028], machines translation), which read on the claimed compounds.

With respect to claim 35, JP ('618 A) discloses that the straight chain or the branched saturated carboxylic acids can be used (paragraph [0031]), which reads on the claimed carboxylic acids.

Response to Arguments

4. The applicant's arguments filed on November 24, 2008 have been fully considered but they are not persuasive.

First, the applicant argues that JP ('618 A) does not disclose the content of the compound. In response, the examiner notes that the translation of the paragraph [0036] in the JP ('618 A) provided by the applicant on November 24, 2008 was not certified. It is further noted that the content of the organic solvent is determined by the content of the compound to be dissolved in the solvent (paragraph [0036], machine translation). Therefore, the content of the compound is directly related to the content of the solvent. The reason for the rejection of the claim limitation of the content of the compound as stated in the Office action dated August 22, 2008 is proper and maintained.

Second, the applicant argues that JP ('618 A) is silent on the amended features of specific types of the compound, specific carboxylic acids and specific choices of the thicknesses of the covering lay in the instant claims 1 and 15. In response, see the reasons for the rejections of the amended features in the instant claims 1 and 15 and of the new claims 29 and 35 in the paragraph above.

Third, the applicant argues that the particle dispersion used in JP ('618 A) may further comprise another compound having reactivity to the group containing a nitrogen atom, an oxygen atom or a sulfur atom used to accelerate removal of the compounds

forming coatings on the particles from the surface of the particles when the heating-up treatment is carried out. In response, the examiner notes that the arguments of the counsel cannot be relied upon as evidence. See MPEP 21206.02. The particle dispersion used in JP ('618 A) does not comprise the compound having reactivity to the group containing a nitrogen atom, an oxygen atom or a sulfur atom as asserted by the applicant.

Fourth, the applicant argues that JP ('618 A) fails to provide any suggestion as to fine particles in the form of dry powder. In response, the examiner notes that JP ('618 A) discloses that the particles dispersion is heat treated at 250°C (abstract), which reads on the evaporation step in the instant claim 1. It would have been obvious to one of ordinary skill in the art that at certain temperature of the heat treatment, the solvent in the dispersion would be evaporated completely and the particles would be in the form of dry powder as claimed.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

WZ

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Application Number**Application/Control No.**

10/595,440

**Applicant(s)/Patent under
Reexamination**

ITOH ET AL.

Examiner

WEIPING ZHU

Art Unit

1793